

REMARKS

This responds to the Office Action mailed on June 17, 2005.

No claims have been amended, canceled, or added. As a result, claims 1-13 remain pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

Rejection of Claims 1-3, 8, 11, and 13 Under 35 U.S.C. §112, First Paragraph

Claims 1-3, 8, 11, and 13 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Regarding claim 1, the Examiner asserted that the description of the control mechanism was not supported by the corresponding description in the specification, e.g. at page 17, lines 9-12.

Claim 1 recites *inter alia*:

“a control mechanism coupled to the pneumatic source, to the vacuum source, to a supply hose, and to a pilot hose, wherein the supply hose and the pilot hose are to couple to a tool, wherein the control mechanism is to provide vacuum to the supply hose when air within the pilot hose has less than a predetermined pressure, and wherein the control mechanism is to provide air pressure to the supply hose when air within the pilot hose has greater than the predetermined pressure.” [emphasis added]

Applicant's specification at page 17, lines 1-12, states:

Limit valve 80 is coupled to line 44, line 64, and pilot hose 84. Limit valve 80 operates as follows. When air is flowing to tool 10 through pilot hose 84 without being blocked within tool 10 by the simultaneous depression of button 101 and tip 185, the air within pilot hose 84 is relatively unpressurized, and limit valve 80 does not let air flow from line 44 through limit valve 80 to line 64. The air within pilot hose 84 only becomes pressurized when actuation button 101 and tip 185 are concurrently depressed. When pilot hose 84 is pressurized, limit valve 80 causes air to flow from line 44 through limit valve to pressurize line 64.

Reversing valve 60 is coupled to line 44, line 64, line 74, and supply hose 86. Reversing valve operates as follows. When line 64 from limit valve 80 is not pressurized, vacuum is connected from line 74 to supply hose 86. When line 64 is pressurized, air pressure is connected to supply hose 86 from line 44.

The Examiner notes “line 64 is not a pilot hose according to the original filed specification”. Applicant completely agrees with the Examiner. From FIG. 1, it will be seen that line 84 is a pilot hose, as described *inter alia* on page 6, line 17 of the specification.

Thus, Applicant asserts that claim 1 is supported by the corresponding description in the specification. Likewise, claims 3, 8, 11, and 13 are also supported by the same corresponding description in the specification as claim 1.

For the above reasons, Applicant requests that the rejection of claims 1-3, 8, 11, and 13 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Rejection of Claims 1-3, 8, 11, and 13
Under 35 U.S.C. §112, Second Paragraph

Claims 1-3, 8, 11, and 13 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

The Examiner stated that these claims were indefinite because the conditions set forth in them lack proper antecedent basis.

As asserted above, these claims are fully supported by the original description, and Applicant accordingly requests that the rejection of claims 1-3, 8, 11, and 13 under 35 U.S.C. §112, second paragraph, be withdrawn.

Rejection of Claims 1, 10, and 11
under 35 U.S.C. §102(b)
as Anticipated by Hood

Claims 1, 10, and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by Hood (U.S. 5,352,230).

Hood discloses a pneumatic tool having a chamber 24 (FIG. 2), a first port 44 (FIG. 3), a second port 46, a reciprocating shuttle 36 (FIG. 2b), an anvil 122, and a control unit 12 (FIG. 1). During a first (percussive) part of a cycle, air pressure is applied to the first port 44, and vacuum is applied to the second port 46 (col. 13, lines 1-5), driving the shuttle to the distal end of the chamber to strike the anvil. During a second (recovery) part of a cycle, vacuum is applied to the first port 44, and pressure is applied to the second port 46, to return the shuttle to the proximal end of the chamber.

The rule under 35 U.S.C. §102 is well settled that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Hood fails to disclose all of the structural elements recited in claim 1. For example, Hood fails to disclose *inter alia* that the control mechanism is to provide vacuum to the supply hose when air within the pilot hose has less than a predetermined pressure, and wherein the control mechanism is to provide air pressure to the supply hose when air within the pilot hose has greater than the predetermined pressure.

For the above reasons, claim 1 should be found to be allowable over Hood, and Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102(b) as anticipated by Hood be withdrawn.

Regarding independent claim 9, Hood fails to disclose *inter alia* a first operator-actuatable actuation element and a second operator-actuatable actuation element. For the above reasons, claim 9 should be found to be allowable over Hood, and Applicant respectfully requests that the rejection of claim 9 under 35 U.S.C. §102(b) as anticipated by Hood be withdrawn.

Claims 10-11, which depend, directly or indirectly, from claim 9 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Rejection of Claims 4-6 and 9
under 35 U.S.C. §103(a) as Unpatentable
over Hood in view of Erickson

Claims 4-6 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hood in view of Erickson et al. (U.S. 2,679,645).

Hood was discussed previously.

Erickson appears to disclose a stud-driving tool (FIG. 1a) having a body 10, a grip 11 on one end, a firing pin 16, an explosive cartridge 22, a stud 21, and a pad structure 27 (FIG. 1b). In operation (as described in col. 4, beginning line 31), the muzzle end of the tool is pressed against the target surface, and pressure is applied to the tool, so that a firing pin latch 48 is engaged with a notch 54 of a control cam 13. The operator rotates the grip 11, disengaging the firing pin latch 48, causing the firing pin 16 to impact the cartridge 22 and drive the stud 21.

Applicant could find no disclosure in Erickson concerning a pneumatic or air source, a vacuum source, or a control mechanism coupled to a pneumatic or air source and to a vacuum source. This is not surprising, because Erickson is apparently concerned only with an explosive-drive stud, not with a tool that uses a pneumatic source and a vacuum source.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Hood in view of Erickson fails to teach or suggest all of the claim limitations present in independent claims 4 and 9, so a *prima facie* case of obviousness has not been established.

Regarding claim 4, for example, neither reference discloses *inter alia*:

a control mechanism coupled to the air source and to the vacuum source, wherein the air source and the vacuum source are to couple to a tool comprising a first operator-depressible actuation element and a second operator-depressible actuation element, wherein the control mechanism is to provide vacuum to the tool when fewer than both actuation elements are actuated, and wherein the control mechanism is to provide air pressure to the tool when both actuation elements are actuated. [emphasis added]

In Hood, there is just one user-operable switch 200 (FIG. 1). No disclosure could be found in Hood teaching or suggesting the use of more than one operator-depressible actuation element (claim 4) or operator-actuatable actuation element (claim 9).

Erickson appears to disclose the use of two actuation elements. However, regarding independent claim 4, no disclosure could be found in Erickson teaching or suggesting the use of a pneumatic source and a vacuum source to provide vacuum to a tool when fewer than both actuation elements are actuated, and to provide air pressure to the tool when both actuation elements are actuated.

Regarding independent claim 9, neither Hood nor Erickson appear to disclose or suggest a pilot hose coupled to a control mechanism, wherein air within the pilot hose has less than a predetermined pressure when fewer than both actuation elements are actuated, and wherein air within the pilot hose has greater than a predetermined pressure when both actuation elements are actuated.

For the above reasons, claims 4 and 9 should be found to be allowable over any combination of Hood and Erickson, and Applicant respectfully requests that the rejection of claims 4 and 9 under 35 U.S.C. §103(a) as being unpatentable over Hood in view of Erickson should be withdrawn.

Claims 5 and 6, which depend, directly or indirectly, from claim 4 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Allowable Subject Matter

Applicant notes with appreciation that claims 2, 3, 8 and 13 were indicated to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, set forth in the Office Action and to include all of the limitations of their base claims and any intervening claims.

Claims 7 and 12 were objected to as being dependent upon a rejected base claim, but they were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In view of Applicant's preceding remarks concerning the asserted patentability of independent claims 1, 4, and 9, Applicant does not wish to rewrite claims 2, 3, 7, 8, 12, and 13 in independent form at this time, but Applicant respectfully reserves the right to do so at a later time.

Conclusion

Applicant respectfully submits that claims 1-13 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Sept. 19, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19th day of September, 2005.

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